UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,167	03/07/2001	Roger Gillman	P/67-1	4310

7590 10/04/2006

Phillip M. Weiss, Esq.
Weiss & Weiss
300 Old Country Road
Suite 251
Mineola, NY 11501

EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/801,167	GILLMAN ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 July 2006 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following excerpts from claims 1 and 8 are indefinite: "said first person and said second person compete with each other professionally" (claim 1 lines 7-8) and "so that members in said networking groups do not compete with each other professionally" (claim 8 lines 6-7). This rejection depends on the interpretation of the term "compete".

4. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

5. The instant application contains no such clear definition for the phrase "compete". In the instant case, the examiner is required to give the term "compete" its broadest reasonable interpretation, which the examiner judges to be seeking to gain at the expense of others, said others being called competitors. The examiner believes that that is the plain meaning and would be readily recognized by one of ordinary skill in the art of competitive enterprise.

6. In the instant application, no standard is disclosed for identifying whether or not a person competes with another person. In the specification, it is disclosed only that

> "For example, two doctors who are both orthopedic surgeons who work in the same area of a city, who may compete (emphasis added) with each other for business, will not be placed in the same networking group". (para. [0007] of the published spec., US 20020128905A1)

"May compete" is not a clear standard, for it leaves open the possibility that said two doctors may not compete. They could in fact be part of the same practice or otherwise cooperate professionally.

7. Applicant argues (p. 5, top) that two car insurance salesman are competitors, and therefore would be placed in different networking groups. But what if said two salesmen worked for the same firm and the first, more senior salesman had been assigned to train the second salesman? Then these two salesmen would not be competitors. Para. [0009] and [0021] of the published application also contain the same flawed logic by presuming that simple professional titles for lawyers can identify competitors. Many lawyers in fact work in practices with other lawyers where they would be responsible for cooperating, not competing, with said other lawyers in the practice.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for other limitations, does not reasonably provide enablement for selecting persons based on whether or not they compete. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

practice the invention commensurate in scope with these claims. No standard is disclosed for selecting persons based on whether or not they compete. See para. 3-7 above.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (US 20020194049A1) in view of Romano ("Meet me in Cyberspace", *Association Management*, September 1998).

12. Boyd teaches (independent claim 1 and 8) a method and system for providing online networking groups, the method comprising: registering three or more users by asking them to store information in *user profile database **213*** (para. **[0064]** and **[0085-0086]**), which reads on entering a profile and a second profile (and a third profile) into a computer database, and creating a networking group (all three or more users/members) contained within said computer database; and a first user forming and posting an invitation to a networking meeting to two or more other users (**[0049** and **0024]**), the *selection preferences and criteria* including that the attendees be *intellectual property attorneys* (**[0031]**), the invitation being placed in *invitation database **211***, which reads on comparing said profile and said second profile (comparing both user profiles to the *selection preferences and criteria*)[1], moving said second profile into a second database (*invitation database **211***) is said second profile and said second profile contain same professions and same areas of practice (*intellectual property attorneys*), and creating a network group (the invited members) contained within said second database (*invitation database **211***).

13. Boyd does not teach networking/meeting online. Romano teaches networking/meeting online (Abstract). Because Romano teaches that this enables networking when members lack the opportunity to interact face-to-face (Abstract), it would have been obvious to one of

[1] Things compared to the same thing are compared to each other.

ordinary skill in the art, at the time of the invention, to add the teachings of Romano to those of Boyd.

14. Neither reference teaches that said first person and said person compete with each other professionally. That is, neither reference teaches that said first person and said person are put in different networking groups when they compete with each other. Because it would be counterproductive to be put competitors into a single networking group, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd and Romano that competitors be placed in different networking groups.

15. The entire purpose of professional networking is to enhance one's business, by finding sales prospects for example, or identifying cheaper ways to do business. One of ordinary skill in the art would readily understand that a person "A" would not tell a competitor "B" such things. It would be counterproductive, because, by definition, competitor "B" would use such knowledge to undercut the business of person "A".

16. Boyd also teaches at the citations given above claim 2 (where the invitation reads on a referral). Boyd also teaches claims 5 ([**0073**]) and 7 ([**0065-0066**]).

17. Neither reference teaches (claims 3 and 4) rewards or positive incentives commensurate with the number of invitations/referrals provided by a user. However, Boyd does teach negative incentives for a user who does not make invitations or violate invitation rules ([**0053, 0073-0075** and **0111**]). Because the system would work only if user make as well as honor invitations, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd rewards or positive incentives commensurate with the number of invitations/referrals provided by a user.

18. Neither reference teaches (claim 6) communicating online via video/audio conferencing. However, Boyd does teach a system with video monitors and cameras ([**0094** and **0101**]). Because Boyd teaches that the purpose of the reference invention is to make the best use of a user's time ([**0006**]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add meeting by video/audio conferencing to the teachings of Boyd and Romano.

19. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (US 20020194049A1) in view of Romano ("Meet me in Cyberspace", *Association Management*,

September 1998), for the reasons given above in para. 12 and 13. The limitation "so that members in said networking groups do not compete with each other professionally" was not given patentable weight because it does not structurally limit the invention. To be patentable, apparatus or system inventions must be structurally distinguishable from the prior art (MPEP § 2114). The subject limitation adds no structure, so it cannot help make the claim-8 apparatus/system invention patentable.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 8:30 AM to 7 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

21. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

26 September 2006

DONALD L. CHAMPAGNE
PRIMARY EXAMINER